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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/479,999 06/28/94 BRAKEL C ENZ-47(C)

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HM12/0926

EXAMINER

MARSCHER, A

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/479,999

Applicant(s)

Brakel et al.

Examiner

Ardin Marschel

Group Art Unit
1631



☒ Responsive to communication(s) filed on Nov 19, 1999 and Petition renewal, filed 3/10/00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-52 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-52 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The art unit designated for this application has changed. Applicants are hereby informed that future correspondence should be directed to Art Unit 1631.

It is noted that a Petition to Revive the instant application has been granted as mailed 4/10/00 and that the instant application has been returned to pending status.

Applicants' arguments, filed 11/19/99, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections are reiterated from the previous office action, mailed 1/4/99. They constitute the complete set presently being applied to the instant application.

Claims 1-19, 21-39, 41, 51, and 52 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims have been amended to now contain NEW MATTER. For example, claim 1 now recites several new components made up of various N, M, and B moieties. These arrangements of said components in line 3 of claim 1 have not been found as filed and thus are NEW MATTER. The closest component arrangements to these is present in claim 21 as filed but do not give written description of these arrangements. Claims 2-19, 21-39, 41, 51,

and 52 also contain this NEW MATTER either directly or indirectly via dependence from a claim that explicitly contains it. This rejection is necessitated by amendment.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 8, 12-14, 19, and 42-50 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miller et al.(1985).

This rejection is reiterated and maintained from the previous office action, mailed 1/4/99. Applicants argue that Miller et al. neither discloses nor suggests not fully modifying all of the internal phosphodiester linkages and is silent on RNase H sensitivity. This RNase H resistance argument is confusing in that instant claim 1, for example, lacks any mention of RNase H resistance or not. Only claims 44 and 49 as rejected hereinunder cite any RNase H practice and these claims, such as specifically claim 44 directs RNase H resistance to what is complexed with the compound of claim 42 and not the compound itself. This argument is thus non-persuasive as being directed to a limitation that is not in the claims under rejection.

Claims 1-4, 12-14, and 42-50 are rejected under 35 U.S.C.

§ 102(b) as being anticipated by Stein et al.(1988).

This rejection is reiterated and maintained from the previous office action, mailed 1/4/99. Applicants argue again as above regarding RNase H resistance. This argument has been responded to above and is equally applicable here and is reiterated here. Applicants then argue regarding partial internal modification that is not in Stein et al. This is non-persuasive as it is based on the NEW MATTER added to the instant claims. This rejection is reiterated in anticipation of removal of the NEW MATTER thus leaving the claims rejected as before.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant

is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walder et al.(1988) in view of Miller et al.(4,469,863) and Inoue et al.(1988).

This rejection is maintained and reiterated as given in the office action, mailed 1/4/99. Applicants argue based on the internal partial modification of the claimed compounds which has been noted above as being NEW MATTER. This rejection is reiterated in anticipation of removal of the NEW MATTER thus leaving the claims rejected as before.

No claim is allowed.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

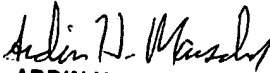
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 22, 2000


ARDIN H. MARSCHEL
PRIMARY EXAMINER